Remarks/Arguments

In the Office Action mailed on July 11, 2005, the Examiner states final rejections of the then pending claims as being anticipated by Ford Patent No. 4,638,966. Claims 16-27 are cancelled. The new claims are submitted as defining patentably over the Ford patent.

In the subject invention, applicant brings to the cable tie industry method and apparatus wherein plural uses are made of the inherent self-bias of cable ties whereby the cable tie tail is disposed in a planar condition.

The first use of the self-bias is to attach a securement member, usable to mount the cable tie, to the cable tie for transport therewith, i.e., the securement member and the cable tie are jointly portable. All components for mounting the cable tie on a mounting panel are thus pre-assembled for deployment in the mounting phase. The Specification states at page 4, e.g., as follows.

> ...the cable tie tail extending through the securement member, the securement member being rotatable relative to the cable tie tail and being portable therewith.

As is seen in Fig. 1, securement member 12 is disposed fixedly on tail 24 of cable tie 22.

The second use of the self-bias is to attach the securement member to the mounting panel in the mounting phase. The Specification states at pages 7-8.

Turning to Fig. 4, the apparatus of Fig. 1 is assembled with mounting panel 26. In reaching the assembly of Fig. 4, portions 24a and 24b of cable tie tail 24 are brought into contacting relation.

At this juncture, securement device 10 is rotated into engagement with either of tail portions 24a and 24b such that securement device 10 is generally aligned with the folded cable tie and has a free end portion extending outwardly of the folded cable tie. Such free end portion is now passed into and through opening 28 of mounting panel 26. Securement device 10 now assumes the disposition thereof shown in Fig. 4, i.e., in facing relation to the rear surface 26a of mounting panel 26 aside opening 28.

Inherent spring strength in the folded cable tie urges securement device 10 into contact with rear surface 26a, thus securing the assembly shown in Fig. 4. Conductors (not shown) may now be nested interiorly of the folded cable tie and the cable tie may be secured tightly thereabout.

The independent, now pending, claims will be taken up with discussion of differences between the express claim content and the Ford disclosure.

Claim 28 reads as follows, with emphasis added.

28. A method for use in assembling conductors with a mounting panel, comprising the steps of:

(a) providing a cable tie having a head and a tail extending from said head, said tail having a self-bias to a planar condition;

(b) attaching a securement member to said tail using the self-bias of said tail to render said securement member portable with said cable tie;

(c) releasing the biased attachment of said securement member and said tail; and

(d) attaching said securement member and said cable tie to said mounting panel using the self-bias of said tail.

Ford's mounting panel is support structure 14, having spaced sidewalls 16. Flanges 18 of sidewalls 16 are spaced from one another and provide support for support member 20. Cable tie 22 has end portions 24 and 26 and arcuate portion 28, which is resident in the support member 20. Cable tie 22 has no contact whatever with support structure 20 flanges 18 and accordingly has no role whatever in attaching support member 20 to support structure 14.

Quite clearly, there is neither disclosure in the Ford patent of "attaching said securement member and said cable tie to said mounting panel using the self-bias of said tail", as claimed in claim 28.

Further, while it is questionable as to whether Ford discloses a self-bias of his tail effecting attachment of his securement member and his cable tie, it is quite clear that Ford does not release a biased relationship of a securement member and cable tie tail.

Ford's slots 40 are confining in relation to his cable tie, since the opposed sides of the slots do not open into the upper and lower surfaces of his securement member, as is clear from Figs. 3 and 5, as above noted. The cable tie tail is accordingly not releasable from a biased relationship (if any exists) with the securement member, as claimed in claim 28.

To the extent that the Ford patent fails to disclose or suggest express content of claim 28, as set forth in recitations (c) and (d) thereof, the Ford patent cannot tenably stand as an anticipation of claim 28 within the meaning of Section 102.

Claim 32 reads as follows, with emphasis added.

> 32. (new) In combination:
>
> (a) a cable tie having a head portion and an elongate tail extending from said head portion, said tail having a self-bias to a planar configuration; and
>
> (b) a securement member extending longitudinally with said tail and defining
>
> (1) first and second perimetrically bounded elongate apertures <u>opening along their lengths into first and second opposed sides of said securement member</u> and
>
> (2) a tail support portion longitudinally between said first and second apertures, said tail being deformed by said securement member from said planar configuration to have an arcuate portion facing said support portion of said securement member, first and second courses of said tail extending from said tail arcuate portion respectively through said first and second apertures and <u>movable out of said first and second apertures</u>, said self-bias of said tail

biasing said securement member into engagement with said tail such that said securement member and said tail are attached with one another to be jointly portable.

Referring to Fig. 3 of the Ford patent, support member 20 defines slots 40 extending therethrough. The slots 40 do not open along their lengths into opposed sides of the support member, as is clear from Fig. 3. The top plan view of Fig. 5 is also clear in this respect, i.e., the slots 40 are not visible therein. This is in contrast to applicant's slots herein, the instant Specification stating as follows at page 7 thereof:

> Referring to Figs. 1-3, securement device 10 is a flat rigid member which may be comprised of metal and which defines opposed flat surfaces 12 and 14. Openings 16 and 18 extend between surfaces 12 and 14 and through securement device 10.

Since applicant's openings are open along their length, his cable tie has courses which are resident in the openings and can be moved through the openings to permit rotation of the cable tie relative to the securement member to have the tail courses folded upon one another to achieve an aligned state with the securement member. The instant Specification thus advises as follow at pages 7 and 8:

> Turning to Fig. 4, the apparatus of Fig. 1 is assembled with mounting panel 26. In reaching the assembly of Fig. 4, portions 24a and 24b of cable tie tail 24 are brought into contacting relation.

> At this juncture, securement device 10 is rotated into engagement with either of tail portions 24a and 24b such that securement device 10 is generally aligned with the folded cable tie and has a free end portion extending outwardly of the folded cable tie. Such free end portion is now passed into and through opening 28 of mounting panel 26. Securement device 10 now assumes the disposition thereof shown in Fig. 4, i.e., in facing relation to the rear surface 26a of mounting panel 26 aside opening 28.

Ford's slots 40 are confining in relation to his cable tie, since the opposed sides of the slots do not open into the upper and lower surfaces of his securement member, as is clear from Figs. 3 and 5, as above noted. The cable tie is accordingly not movable out of the slots as claimed in claim 32.

To the extent that the Ford patent does not disclose or suggest the above-emphasized content of claim 32, the reference cannot tenably stand as an anticipating reference within the meaning of Section 102.

Claim 36 reads as follows, with emphasis added.

> 36. (new) An assembly, comprising:
>
> (a) a cable tie having a self-bias to a planar configuration and having a head portion and an elongate tail extending from said head portion; and
>
> (b) a securement member comprising a flat rigid member which defines first and second opposed surfaces,

(1) a first portion defining a first aperture extending transversely through said member into first and second mutually aligned openings in said first and second surfaces,

(2) a second portion continuous with said first portion and being unapertured, and

(3) a third portion continuous with said second portion and defining a second aperture extending transversely through said member into third and fourth mutually aligned openings in said first and second surfaces,

said cable tie tail having an arcuate course in facing relation with said member second portion and first and second courses successive to said arcuate course and disposed respectively in said member first and second apertures, said self-bias of said cable tie effecting attachment of said cable tie tail to said member and the arcuate formation of said tail arcuate portion, said cable tie first and second courses being supported for rotation outwardly of said first and second apertures about a fulcrum defined by said member second portion.

Referring to Fig. 3 of the Ford patent, slots 40 do not extend transversely to his support member and do not terminate in mutually-aligned openings in opposed surfaces of the member. Further, the Ford cable tie tail is not movable for rotation outwardly of his slots.

To the extent that the Ford patent does not disclose or suggest the above-emphasized content of claim 35, the reference cannot tenably stand as an anticipating reference within the meaning of Section 102.

In keeping with the seeking of "special" status for the subject application to enable applicant to enjoy the results of the subject invention, comments are now made distinguishing the independent claims now pending from the disclosure of O'Grady Patent No. 5,314,154, relied on in past rejections of claims.

In respect of claim 28, O'Grady does not disclose or suggest step (b) of this claimed method, i.e., attaching a securement member to said tail using the self-bias of said tail to render said securement member portable with said cable tie.

In O'Grady's practice, his securement member 10 is not biased by his cable tie until the securement member is in its panel-inserted state (Fig. 10).

Nor does O'Grady disclose or suggest step (c) of claim 28, i.e., lacking disclosure of step (b), i.e., he does not effect release of a biased relation of his securement member and his cable tie tail.

In respect of claim 32, O'Grady does not disclose or suggest first and second perimetrically bounded elongate apertures opening along their lengths into first and second opposed sides of his securement member. Further, lacking plural apertures, O'Grady fails to disclose or suggest "first and second courses of said tail extending from said tail arcuate portion respectively

through said first and second apertures and movable out of said first and second apertures". Indeed, O'Grady's discloses but one aperture (18), and his cable tie tail is not movable out of such one aperture.

In respect of claim 36, O'Grady does not disclose or suggest a support member having plural transverse apertures extending therethrough into mutually aligned openings nor movement of his cable tie outwardly of plural apertures.

To the extent that the O'Grady patent does not disclose or suggest the above-emphasized content of claims 28, 32 and 36, the reference cannot tenably stand as an anticipating reference within the meaning of Section 102.

Turning to Section 103, the Federal Circuit has advised that, for an invention to be considered obvious, there need not be an explicit "suggestion" in the prior art. It is only necessary that the inventor applied "knowledge clearly present in the prior art". In re Sernaker, 217 USPQ 1, 6 (1983). In reversing the Board, the Court expressly noted that none of the prior art disclosed what the applicant had done in his invention.

As for claims 28, 32 and 36, there is clearly no prior art knowledge of applicant's method or apparatus based on distinctions over the prior art discussed above.

Reliance is placed on In re Fine, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and Ex parte Kochan, 131 USPQ 204 (Bd. App. 1960) for allowance of the dependent claims, since they differ in scope from parent independent claims submitted as patentable. Patentability of all claims is believed to have been established and, as such, it is submitted that this application is now in condition for allowance. Indication to that effect is solicited.

Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone undersigned counsel for applicant at (908) 654-3848.

Respectfully submitted,

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